

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed January 13, 2006.

Claims 52-90 are currently pending.

Previous Response

In the first paragraph of the current Office Action, the Examiner alleges that "Applicant failed to properly elect distinct species ..." Applicant respectfully disagrees. In the last Office Action, the Examiner stated "If the applicant elected Group I, the applicant is required to elect one of the following distinct species ..." Since Applicant did not elect Group I in response to the previous Office Action, Applicant asserts that Applicant was not required by the Examiner to elect a species.

The Examiner also stated that claims 35-37 improperly depend from claim 32. Applicant respectfully disagrees. These claims are Product-by-Process claims. Applicant points the Examiner to MPEP 2173.05(p), which states "A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper."

Election

In the current Office Action, the Examiner issued a second restriction requirement that required the claims to be restricted to one of two alleged inventions: (1) Group I, including claims 32-34 and 47-51, drawn to a method of manufacturing a peripheral card, classified in class 29, subclass 593; and (2) Group II including claims 35-46, drawn to a peripheral card, classified in class 439, subclass 60. Applicant hereby elects to proceed with Group I, including claims 32-34 and 47-51. Claims 35-46 have been cancelled without prejudice so that they can be submitted with a divisional application. Applicants make this election to further the prosecution process. This election is not meant to indicate that the Applicant agrees or disagrees with the restriction requirement.

Species

The Examiner also required the Applicant to make two elections with respect to species. Specifically, Applicant is required to elect between Species 1 (a liquid), Species 2 (a film), and Species 3 (a transfer mold process). Applicant is also required to elect between Species a (prior to applying step) and Species B (after applying step). Applicant disagrees with the requirement to elect species. The Examiner has not provided a factual basis for the requirement to elect a single species. For example, Applicant does not see how Species 3 should be in the same election as Species 1 and 2. To further the prosecution process, however, Applicant will make an election.

It is not clear to the Applicant whether the Applicant should elect one of the five species or elect one species between Species 1 (a liquid), Species 2 (a film), and Species 3 (a transfer mold process) and one species between Species a (prior to applying step) and Species B (after applying step).

Applicant is assuming that Applicant is supposed to elect one species from each group; therefore, Applicant elects Species 2 (a film) and Species a (prior to applying step). If Applicant is only supposed to elect one species, then Applicant elects Species 2 (a film).

Telephone Conference

On February 16, 2006, Applicants' undersigned attorney participated in a telephone conference with the Examiner. Two topics were discussed during that telephone conference: (1) the scope of Species a and b, and (2) adding back of original claims 1-31.

The Examiner explained that Species a was defined by original claim 20 and Species b was defined by original claim 21.

Applicant noted to the Examiner that the first restriction requirement from the Officer Action dated October 25, 2005 restricted original claims 1-31 into the same Group 1 that the Examiner is restricting claims 32-34 and 47-51 in the current Office Action. In paragraph 2 of both Office Actions, the Examiner stated that the claims "are related as process of making ...". Both sets of Group 1 claims are method claims that are classified in class 29, subclass 593. Therefore, the Applicant noted that if the Applicant chooses group 1 in response to the current Office Action, then the Applicant should be able to proceed with claims 1-31, as well as claims

32-34 and 47-51. The Examiner agreed and said that the Applicant can add back claims 1-31 if the Applicant chooses Group 1 because they would all be drawn to a method.

New Claims

In response to the telephone conference described above and the current Office Action, Applicant is cancelling claims 35-46 and reinstating original claims 1-31. However, in keeping with patent office practice, Applicant has added claims 1-31 as new claims 52-82. Additionally, for consistency purposes, claims 32-34 have been cancelled and reinserted as claims 83-85. For consistency purposes, claims 47-51 have been cancelled and reinserted as claims 86-90. Therefore, claims 52-90 are currently pending.

New claims 52, 60-73, 75-78, 80-83, 85, 86, and 88-90 read on Species 2 (a film). Note that claims 52, 64-69, 71-73, 76-78, 81-83, 86 and 89-90 are generic to Species 1, 2 and 3.

New claims 52-71, 73-76, and 78-90 read on Species a (prior to applying step). Note that claims 52-70, 73-76 and 79-90 are generic to Species a and b.

Applicant notes that none of the claims have been amended, other than renumbering. Therefore, it is not necessary to point out support. Additionally, the limitations of the pending claims can be found in the originally filed claims. That is, new claims 52-82 correlate to original claims 1-31, new claims 83-85 correlate to original claims 32-34 and new claims 86-90 correlate to original claims 47-51.

Conclusion

In view of the above Amendments and Remarks, consideration of claims 52-89 is requested.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this document, including any fee for extension of time, which may be requested.

Respectfully submitted,

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